REMARKS

Claims 1-7 currently are pending in the above-captioned patent application and are subject to examination. Reconsideration of the above-captioned patent application is respectfully requested in view of the following remarks.

In the Office Action mailed July 13, 2004, the Examiner rejected claims 1-7 under 35 U.S.C. § 103(a), as allegedly being rendered obvious by U.S. Patent No. 5,480,013 to Fujiwara *et al.* ("Fujiwara").

In order for the Examiner to establish a prima facie case for obviousness, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable expectation of success in connection with the Examiner's proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143. Applicants submits that the Examiner fails to satisfy his burden of establishing a prima facie case for obviousness because (1) the Examiner fails to show that Fujiwara discloses or suggests all of the claimed limitations of claims 1-7; and (2) the Examiner fails to show that those of ordinary skill in the art would have been motivated to modify Fujiwara to achieve applicants' claimed invention.

Specifically, Applicant's independent claim 1 describes a one-way clutch in which "the first cage includes a plurality of retaining pockets for retaining the sprags and at least one non-retaining pocket which does not retain [any of] the sprags." As such, in the one-way clutch described in independent claim 1, the first cage includes at least one

more pocket (retaining pockets plus the at least one non-retaining pocket) than there are sprags.

The Examiner acknowledges that Fujiwara does not disclose or suggest non-retaining pockets. However, the Examiner asserts that "it would have been obvious to [modify Fujiwara to] omit sprags resulting in non-retaining pockets when its function or torque capability is not needed." Applicants respectfully disagree.

Specifically, as set forth in Applicants Background of the Invention, in known one-way clutches (such as the one-way clutch described in Fujiwara), the number of pockets formed corresponds to the number of sprags employed. Applicants submit the if one of ordinary skill in the art were motivated to modify the one-way clutch described in Fujiwara to reduce the number of sprags employed, e.g., because the additional torque capacity is not needed, then based on the teachings of the prior art, one of ordinary skill in the art also would be motivated use a cage having a reduced number of pockets, such that the number of pockets correspond to the number of sprags. However, the teachings of the prior art **would not motivate one of ordinary skill in the art to reduce the number sprags without also reducing the number of pockets**. The only teaching related to the advantages of having more pockets that sprags on one or more of the cages comes from the disclosure of the above-captioned patent application. As such, Applicants respectfully submit that the Examiner is relying on impermissible hindsight in view of the disclosure of the above-captioned patent application to find motivation to reduce the number of sprags without making a corresponding reduction in the number of pockets. Therefore, Applicants respectfully request that the Examiner withdraw the obviousness rejection of independent claim 1.

Claims 2-5 depend from allowable independent claim 1. Therefore, Applicant respectfully requests that the Examiner also withdraw the rejection of claims 2-5.

CONCLUSION

Applicants respectfully submit that the above-captioned patent application is in condition for allowance, and such action is earnestly solicited. If the Examiner believes that an in-person or telephonic interview with Applicants' representatives would expedite the prosecution of the above-captioned patent application, the Examiner is invited to contact the undersigned attorney of records. Applicants believe that no fees are due as a result of this submission. Nevertheless, in the event of any variance between the fees determined by Applicants and those determined by the U.S. Patent and Trademark Office, please charge any such variance to the undersigned's Deposit Account No. 01-2300.

Respectfully submitted,

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